UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,419	06/29/2001	Calvin Morrell JR.	16704-14	2274

7590   09/13/2004

OPPENHEIMER WOLFF & DONNELLY LLP
38TH FLOOR
2029 CENTURY PARK EAST
LOS ANGELES, CA 90067-3024

EXAMINER
JEAN GILLES, JUDE

ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>29 June 2001</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-10</u> is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-10</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☒ accepted or b)☐ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a)☐ All   b)☐ Some * c)☒ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)
1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

This office action is responsive to communication filed on 06/29/2001.

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1-3 are rejected under 35 U.S.C. 102(e) as being unpatentable by

Gupta et al (U.S. 6,487,538 B1).

Regarding claim 1: Gupta et al teach a method for generating Internet

reward advertising to at least one user that may be accessed by a retailer

(column 6, lines 10-20, 35-37), the method comprising:

a host website providing the user access to a host website having a

retailer advertisement functionally linked to a retailer website (column 6, lines 32-

45; fig 3, items 223, 226, 200, 221);

optionally the host website receiving a payment from the retailer for

hosting the retailer advertisement (column 6, lines 32-45);

the host website or retailer website or host website and retailer website

directing a reward to the user upon the user completing a designated transaction

at the retailer website (column 6, lines 32-45),

optionally, the retailer website directing a reward to the host website

(column 6, lines 32-45; Note that the reward is expressed in the prior art in the

form of a "cost" associated with certain advertisement information).

Regarding claim 2: Gupta et al teach the method of claim 1, wherein the

payment from the retailer to the host website is a base fee payment, an

incentive-based advertising fee payment or a combination of a base fee payment

and an incentive-based advertising fee payment (column 4, lines 25-31).

Regarding claim 3: Gupta et al teach the method of claim 2, wherein the

incentive-based advertising fee payment is proportionate to the number of

originations generated by users selecting the retailer ad on the host site, thereby

accessing the retailer website (column 4, lines 32-36, column 5, lines 58-61).

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described
> as set forth in section 102 of this title, if the differences between the subject matter sought to
> be patented and the prior art are such that the subject matter as a whole would have been
> obvious at the time the invention was made to a person having ordinary skill in the art to which
> said subject matter pertains. Patentability shall not be negatived by the manner in which the
> invention was made.

4.   Claims 4-10 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Gupta et al (U.S. 6,487,538 B1) in view of Klug et al. (U.S. 6,615,251 B1).

Regarding claim 4: Gupta et al teach the method of claim 1, but fail to

disclose a method wherein the amount of the reward to the user *and* the amount

of the optional reward to the host website is calculated by a payment

disbursement model. Gupta et al differs from the current invention by teaching a step where the amount of the optional reward to the host website is calculated by a payment, but fails to teach a method wherein the amount of the reward to the user and the amount of the optional reward to the host website is calculated by a payment (column 4, lines 32-36).

However, Klug et al (column 3, lines 40-44) teach a step where the amount of the reward to the user is calculated by a payment. Klug et al disclose for instance a credit towards free Internet access time or other value can be used as an incentive to and a reward for participation.

Therefore, it would have been obvious for an ordinary skill in the art at the time of applicant's invention to integrate Gupta et al's method for generating Internet reward advertising for the host website with Klug et al's internet reward advertising for the user to obtain the functional and economic benefit of the invention.

The combination of Gupta et al and Klug an al teach that it is old and well known in the computer networking art to get the advantage of expanding targeted audiences in the Internet advertising business. An artisan in the networking art at the time of the invention would have been motivated to include this combination in order to get this advantage in a network environment.

Regarding claim 5: Gupta et al teach a method for providing rewards that comprises: a host website providing a click-through retailer advertisement to a use; and a host website receiving payment from the retailer in exchange for posting the click-through retailer advertisement functionally linked to a retailer

website (column 4 lines 32-36). Klug an al teach a method for providing rewards
to at least one user that comprises a host website directing the payment to the
user upon the user clicking-through the retailer advertisement, and the user
optionally completing a designated transaction at the retailer website (fig. 1,
items 16, 18; column 8, 13-17).

Therefore, it would have been obvious for an ordinary skill in the art at the
time of applicant's invention to integrate Gupta et al's host website receiving
payment with Klug et al's Internet user receiving payment from retailer, to obtain
the functional and economic benefit of the invention.

The combination of Gupta et al and Klug an al teach that it is old and well
known in the computer networking art to get the advantage of expanding targeted
audiences in the Internet advertising business. An artisan in the networking art
at the time of the invention would have been motivated to include this
combination in order to get this advantage in a network environment.

Regarding claim 6: Klug et al teach a method for providing a reward to a
user, that comprises a host website collecting registration information from the
user, whereby said user becomes a registered member (column 12, lines 4-27;
fig. 5, items 100, 108) and optionally, a host website collecting a membership fee
from the registered member (column 27, lines 4-10). Klug et al, further disclose a
retailer website providing a reward to a registered member completing a
qualifying transaction at the retailer website (column 3, lines 40-47). In addition
Klug et al teach a host website optionally placing automated software on a data
storage device utilized by the registered member (fig. 5, items 144, 152, 128);

Gupta et al teach a host website providing a user access to a host website having a retailer advertisement enabling the user to access the retailer website (column 12 lines 42-50; Note that there are a number of other third party advertisements or retailers that may be present on the page); and optionally, the host website or retailer website or both the host website and retailer website directing at least a portion of the reward to the registered member through the automated software.

Therefore, it would have been obvious for an ordinary skill in the art at the time of applicant's invention to integrate Gupta et al's retailer advertisement functionality with Klug et al's host website collecting registration information from the user, to obtain the functional and economic benefit of the invention.

The combination of Gupta et al and Klug an al teach that it is old and well known in the computer networking art to get the advantage of user registration and e-commerce retailers in the Internet business. An artisan in the networking art at the time of the invention would have been motivated to include this combination in order to get this advantage in a network environment.

Regarding claim 7: Gupta et al teach a host website providing a user access to a host website having a retailer advertisement enabling the user to access the retailer website, but fail to teach a method wherein the registration information includes data descriptive of a method for the registered user to collect the reward. However Klug et al teach a method where "credit towards free Internet access time or other value may be provided as an incentive to and reward for user registration and participation" (column 3, lines 42-45).

Therefore, it is advantageous for an ordinary skill in the art at the time of applicant's invention to integrate Gupta et al's host website and retailer with Klug et al's reward method collecting registration information from the user, to obtain the functional and economic benefit of the invention. It would have been obvious for an artisan in the art to add information describing the method for the user to collect the reward at the time of registration.

The combination of Gupta et al and Klug et al teach that it is old and well known in the computer networking art to get the advantage of user information in and available method of payment the Internet business at the time of registration. An artisan in the networking art at the time of the invention would have been motivated to include this combination in order to get this advantage in a network environment.

Regarding claim 8: Gupta et al teach a data processing device (fig. 3, item 100), but fail to disclose an automated software executed on a user's data processor device for providing rewards to the user.

However Klug et al teach "a user site or a user information database that must be maintained on the user node" to substancially automate the user registration process (column 3, lines 61-64).

Therefore, it is advantageous for an ordinary skill in the art at the time of applicant's invention to integrate Gupta et al's data processing client with Klug et al's registration and reward method, to obtain the functional and economic benefit of the invention. Furthermore, it would have been obvious for an artisan in

the art to use the automated database software on the user's computer to collect

user reward as well as keeping registration data.

The combination of Gupta et al and Klug et al teach that it is old and well

known in the computer networking art to get the advantage of rewarding users

utilizing the automated software installed on the user's computer. An artisan in

the networking art at the time of the invention would have been motivated to

include this combination in order to get this advantage in a network environment.

Regarding claim 9: The combination of Gupta et al and Klug et al teach

the method of claim 8, an automated software on the user's device to provide

rewards to the user. Klug et al further teach that the reward includes at least one

manufacturer-sponsored rebate or a retailer incentive-based advertising fee

payment (column 3, lines 42-47).

Therefore, it is advantageous for an ordinary skill in the art at the time of

applicant's invention to integrate Gupta et al's data processing client with Klug et

al's reward method, to obtain the functional and economic benefit of the

invention. Furthermore, it would have been obvious for an artisan in the art to use

the incentive based advertisement fee payment to expand the clientele.

The combination of Gupta et al and Klug et al teach that it is old and well

known in the computer networking art to get the advantage of using a retailer

incentive-based to encourage users to participate in the ad campaign. An artisan

in the networking art at the time of the invention would have been motivated to

include this combination in order to get this advantage in a network environment.

Regarding claim 10: Klug et al teach a payment disbursement model executed within a system for providing rewards (column 3, lines 42-47), but fails to disclose a payment disbursement model executed within a system for calculating the amount of a reward to be provided to a user on a host website or both a user and a host website. However, Gupta et al (column 5, lines 58-61) teach for instance that "payment schemes may be based on the number of hits; the hit count as number of page impressions must be determined".

Therefore, it is advantageous for an ordinary skill in the art at the time of applicant's invention to integrate Klug et al's system for providing rewards with Gupta et al's system for calculating the amount of a reward, to obtain the functional and economic benefit of the invention. Furthermore, it would have been obvious for an artisan in the art to calculate reward fee payment to expand the clientele.

The combination of Gupta et al and Klug et al teach that it is old and well known in the computer networking art to get the advantage of using rewards to encourage users to participate in the ad campaign. An artisan in the networking art at the time of the invention would have been motivated to include this combination in order to get this advantage in a network environment.

Conclusion

5.   Any inquiry concerning this communication or earlier communications from examiner should be directed to Jude Jean-Gilles whose telephone number is

(703) 305-0269. The examiner can normally be reached on Monday-Thursday and every other Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3719.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Jude Jean-Gilles

Patent Examiner

Art Unit 2143

JJG

August 26, 2004

RUPAL DHARIA
SUPERVISORY PATENT EXAMINER